



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,827	04/15/2005	Richard J. Bies	A8400	4006
23373 7590 09/02/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
EKPO, NNIENNA NGOZI				
ART UNIT		PAPER NUMBER		
2623				
MAIL DATE		DELIVERY MODE		
09/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/523,827

**Applicant(s)**

BIES, RICHARD J.

**Examiner**

Nnenna N. Ekpo

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Acknowledgment***

1. This Office Action is responsive to the remarks filed on June 3, 2008.

***Information Disclosure Statement***

2. The references listed in the Information Disclosure Statement filed on February 08, 2005 have been considered by the examiner (see attached PTO-1449 form).

***Specification***

3. Previous objection to the abstract is withdrawn in view of Applicant's amendment filed on 06/03/2008.

***Response to Arguments***

4. Applicant's arguments filed 06/03/2008 have been fully considered but they are not persuasive.

Applicant argues on pages 10-15 of the 06/03/2008 Remarks, that Stettner (2002/0104090) does not teach or suggest "a user search received via the digital broadcast channel of the television network and retrieving the advertising information from said data gateway based on the user search". As recited in claim 1.

In response to applicant's argument, the examiner respectfully disagrees. Stettner discloses "a user search received via the digital broadcast channel of the television network and retrieving the advertising information from said data gateway based on the user search" (see paragraphs 0049-0050, a user search (requesting information) is performed on a television channel as shown in fig 4, a result is displayed based on the search/query performed by the user as discussed on paragraphs 0058,

0063. A user command which is considered as a user search is performed when a user interacts with the advertisement via a remote control on any input device; the user's remote control produces a "user command" which automatically communicates to the merchant, who fulfils the customer's response to the interactive advertisement. Note further that the interactive advertisements contain triggers "commands" which are responsive to user commands received via a user input device).

5. With regards to claim 10, Applicant argues that Stettner does not disclose "how the advertising contents are generated" and "an interface configured to receive content information from an advertiser via an internet".

In response to applicant's argument, the examiner respectfully disagrees. Stettner discloses "how the advertising contents are generated" on paragraphs 0042-0048) and "an interface configured to receive content information from an advertiser via an internet" on paragraphs 0039-0041, 0049-0051).

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Claims 1, 3-7, 9-14, 16-19** are rejected under 35 U.S.C. 102(a) as being anticipated by Stettner (U.S. Publication No. 2002/0104090).

Regarding **claim 1**, Stettner discloses a television network content delivery system (see fig 1) configured to provide advertising information (see paragraph 0009) via a digital broadcast channel of a television network (fig 1 (cable network, 134) and paragraph 0023, lines 10-12), said television network content delivery system comprising:

a data gateway (local studio, 106) configured to store the advertising information, the advertising information being adapted by a cable content generator for transmission (distributed) over the digital broadcast channel of the television network (cable network, 134) based on content information received from an advertiser (merchant, 122) over an internet (internet, 124) (see paragraph 0032 and fig 1);

an advertising information retriever (STB, 152) configured to process a user search received via the digital broadcast channel of the television network (see paragraph 0049-0050), and to retrieve the advertising information from said data gateway based on the user search (see paragraph 0058, 0063); and

an advertising information provider (provider, 108) configured to transmit, based on the user search, advertising information retrieved by said advertising information retriever via the digital broadcast channel of the television network (see paragraphs 0032-0033 and 0037-0039, the (STB, 152) automatically sends the user's command to the Merchant 122 of the interactive advertisement for additional information relating to the advertisement, which is serviced by advertising information provider, 108).

Regarding **claim 3**, Stettner discloses everything claimed as applied (*see claim 1*). The television network content delivery system, wherein the advertising information includes at least one of an advertiser listing, a text message, a survey questionnaire, a picture, an audio clip, and a video clip (images, 316) (*see paragraph 0040, lines 1-5, the source may provide images which is considered as a video clip*).

Regarding **claim 4**, Stettner discloses everything claimed as applied (*see claim 1*). The television network content delivery system, wherein the television network content delivery system is implemented as at least two data processors comprising a cable headend server (H/E, 306) and a master server (source, 304) (*see fig 3*).

Regarding **claim 5**, Stettner discloses everything claimed as applied (*see claim 1*). The television network content delivery system, wherein the user search is an advertiser search command (*see paragraph 0050-0051, by pressing the information button, more details on a product is displayed or retrieved*).

Regarding **claim 6**, Stettner discloses everything claimed as applied (*see claim 5*). The television network content delivery system, wherein the advertiser search command includes at least one of an advertising information geographic selection (customer's geographical location) and an advertising information temporal selection, selecting, respectively, advertising information designated by the advertiser for a designated geographical area and advertising information designated by the advertiser

for a designated time period (the time in which the interactive advertisement, 402 was displayed) (see paragraph 0057).

Regarding **claim 7**, Stettner discloses everything claimed as applied (*see claim 5*). The television network content delivery system, wherein the advertiser search command is for a category of advertising, the category of advertising being one of a field of business endeavor of the advertiser, type of organization of the advertiser, and type of product advertised by the advertiser (product supplemental information, e.g. airline tickets) (see paragraph 0050, 0055).

Regarding **claim 9**, Stettner discloses everything claimed as applied (*see claim 1*). The television network content delivery system, wherein the advertising information retriever is further configured to process another user search including one of a response to a survey questionnaire transmitted to the user as the advertising information and an order for a selected product (see paragraph 0051, sending a command to the STB to request a fulfillment of the response reads on an order for a selected product).

Regarding **claim 10**, Stettner discloses an advertising content interface configured to provide advertising information (ad servers, 314, image sources, 316, streaming video sources, 318) adapted for transmission over a digital broadcast

channel of a television network by a television network headend (H/E, 306), said advertising content interface comprising (see fig 3):

an interface unit (source, 304) configured to receive content information from an advertiser via an internet (internet, 302) (see paragraphs 0039-0041, 0049-0051);

a cable content generator configured to process the content information received by said advertiser interface and to generate advertising information adapted for transmission over the cable network (see paragraphs 0042-0048); and

a data gateway configured to store the advertising information generated by said cable content generator and to respond to an information demand from the cable network by providing the advertising information to the cable network headend for transmission over the cable network (see paragraphs 0042-0043 and fig 3).

Regarding **claim 11**, Stettner discloses everything claimed as applied (see *claim 10*). The advertising content interface, wherein the data gateway provides the advertising information to the cable network headend (distribution center, 306) for transmission over the cable network responsive to the information demand, the information demand being a transmission of a user command (customer's response to an advertisement to the web site) over the cable network by a user (see paragraphs 0042-0044).

Regarding **claim 12**, Stettner discloses everything claimed as applied (see *claim 10*). The advertising content interface, wherein the content information includes at least



geographic parameter (customer's geographical location) and temporal parameter, such that the cable network transmits the advertising information corresponding to the content information only within, respectively a geographical area and time period (the time in which the interactive advertisement, 402 was displayed) (see paragraph 0057).

Regarding **claim 13**, Stettner discloses everything claimed as applied (*see claim 10*). The advertising content interface, wherein the advertising information includes at least one of an advertiser listing, a text message, a survey questionnaire, a picture, an audio clip, and a video clip (images, 316) (see paragraph 0040, lines 1-5, the source may provide images which is considered as a video clip).

Regarding **claim 14**, Stettner discloses everything claimed as applied (*see claim 10*). The advertising content interface, further comprising a business mediator (merchant, 122), configured to validate an order from the advertiser, the order requesting transmission of the content information to be transmitted (see fig 1 (122)).

Regarding **claim 16**, Stettner discloses a method of receiving content information and to provide advertising information over a cable network, said method comprising:  
receiving content information from an advertiser via an internet (see paragraph 0032, lines 12-15);

processing the content information received and generating advertising information adapted for transmission over the cable network (see paragraphs 0042-0044);

storing the generated advertising information (see paragraph 0043, lines 4-7);  
receiving via the digital broadcast channel of the television network an advertising search and retrieving the stored advertising information according to the advertising search (see paragraph 0058, 0063); and

providing the retrieved advertising information via the digital broadcast channel of the television network (see paragraphs 0032-0033 and 0037-0039).

Regarding **claim 17**, Stettner discloses everything claimed as applied (*see claim 16*). The method, wherein the advertising search includes at least one of an advertiser listing, a text message, a survey questionnaire, a picture, an audio clip, and a video clip (images, 316) (see paragraph 0040, lines 1-5, the source may provide images which is considered as a video clip).

Regarding **claim 18**, Stettner discloses everything claimed as applied (*see claim 16*). The method wherein the advertising search includes at least one of an advertising information geographic selection (customer's geographical location) and an advertising information temporal selection, selecting, respectively, advertising information designated by the advertiser for a designated geographical area and advertising

information designated by the advertiser for a designated time period (the time in which the interactive advertisement, 402 was displayed) (see paragraph 0057).

Regarding **claim 19**, Stettner discloses everything claimed as applied (see *claim 16*). The method, further comprising processing a user search including at least one of a response to a survey questionnaire transmitted as the advertising information and an order for a selected item based on the advertising information (see paragraph 0051, sending a command to the STB to request a fulfillment of the response reads on an order for a selected item based on the advertising information).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 2 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stettner (U.S. Publication No. 2002/0104090) as applied to *claim 1* above, and further in view of Thomas et al. (U.S. Publication No. 2008/0196053).

Regarding **claim 2**, Stettner discloses everything claimed as applied (see *claim 1*). Stettner discloses wherein the user search is transmitted by a user via a set-top box to the digital broadcast channel of the television network (see paragraph 0051).

However, Stettner fails to specifically disclose the user search comprises designating a category of advertising,

based on the designated category, the advertising information retriever searches advertising information listings stored in the data gateway and selects the advertising listings that match the designated category and other criteria,

said other criteria comprises at least a geographical location of the user, and the set-top box or the television is connected to the television network via at least one of a cable wire, an antenna receiving a television broadcast frequency, a satellite dish or other wireless connection.

Thomas et al. discloses the user search comprises designating a category of advertising (see cited portion, but not limited to paragraph 0070, lines 9-11),

based on the designated category, the advertising information retriever searches advertising information listings stored in the data gateway and selects the advertising listings that match the designated category and other criteria (see cited portion, but not limited to paragraph 0070, lines 11-17),

said other criteria comprises at least a geographical location of the user (see cited portion, but not limited to paragraph 0070, lines 3-6), and

the set-top box or the television is connected to the television network via at least one of a cable wire, an antenna receiving a television broadcast frequency, a satellite dish or other wireless connection (see cited portion, but not limited to paragraph 0032 and 0033).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stettner's invention with the above

mentioned limitation as taught by Thomas for the advantage of receiving desired advertisements.

Regarding **claim 20**, Stettner discloses everything claimed as applied above (see *claim 1*). However, Stettner is silent on the television network content delivery system wherein the user search is provided to the television network via a satellite network.

Thomas et al. discloses the television network content delivery system wherein the user search (see fig 1 (32), the user search is performed at system (32)) is provided to the television network (see fig 1 (28)) via a satellite network (see fig 1 (34) communication link includes satellite link) (see cited portion, but not limited to paragraph 0033).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stettner's invention with the above mentioned limitation as taught by Thomas for the advantage of receiving desired advertisements.

10. **Claims 8 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stettner (U.S. Publication No. 2002/0104090) as applied to *claims 1 and 10* above, and further in view of Merriman et al. (U.S. Patent No. 5,948,061).

Regarding **claims 8 and 15**, Stettner discloses everything claimed as applied above (see *claims 1 and 10*). Stettner discloses digital broadcast channel of the television (see fig 1 (cable network, 134)).

However, Stettner fails to specifically disclose generating a report about the delivery of advertising information indicating the number of times the advertising information was viewed.

Merriman et al. discloses generating a report about the delivery of advertising information indicating the number of times the advertising information was viewed (see col. 6, lines 12-26).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Stettner's invention with the above mentioned limitation as taught by Merriman et al. for the advantage of efficiently tracking which advertisements are reaching target groups and generating product interest.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nnenna N. Ekpo whose telephone number is 571-270-1663. The examiner can normally be reached on Monday - Friday 7:30 AM-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 571-272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Annan Q Shang/  
Primary Examiner, Art Unit 2623

NNE/nne  
August 26, 2008.